



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,381	03/28/2001	Masaru Iwagaki	01165/LH	3744

1933 7590 02/04/2003

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

MATHEWS, ALAN A

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,381

Applicant(s)

IWAGAKI ET AL.

Examiner

Alan A. Mathews

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Numeral "4" has been described as two different elements or concepts. On page 10, line 14, element "4" has been described as a "reception destination". But on the last line of page 13, element 4 has been described as an "image plane". In addition, numeral "10" has been described as three different elements or concepts. On page 13, line 22, element "10" has been described as an "index system". On page 14, lines 1 and 2, element "10" has been described as "one sheet". On page 20, line 10, element "10" has been described as "an electronic image". Applicant should check the specification for other possible errors or ambiguities that the Examiner may have missed.

Clarification or correction of the objection to the specification is required.

Claim Rejections - 35 USC § 112

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, the terms "image retrieving soft" and "image discriminating soft" is indefinite. It is not clear what is meant by these terms, and in particular, what is meant by the term "soft".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 - 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Garfinkle et al. (U. S. Patent No. 6,017,157). Garfinkle et al. discloses in figures 1 and 2 a photographer 8 (second party) taking or sending film 9b to a store or developer 12. Column 3, lines 3-10 states that the establishment which receives the roll of film for development will be referred to as the “developer” 12. The developer 12 may only act as an intermediary between the photographer 8 and the entity that actually develops the roll of film, or the developer 12 may actually develop the roll of film. The photographer inherently selects whether or not to receive the electronic image information transmitting service when the photographer takes or sends the film to the developer 12 (why else would the first party do all the extra work required to provide an electronic image). Furthermore, the photographer “selects” to receive an electronic image when he accesses the thumbnail images through the interface B. The first party can include elements 12, 14, 16, and 20, which could be the same entity (see column 3, lines 16-19). The first party converts a developed photographic film or a developed photographic paper into an electronic

Art Unit: 2851

image by scanner 9d in scanning center 14 (see column 3, lines 33-50). The image server "16 "accumulates" (stores) the electronic image information in an accumulating means (see column 4, lines 49 and 50). Interface B transmits the electronic image information by a transmitting means through a communication means to a reception destination designated by the photographer 8 (second party). This reception destination could be the photographer himself. Furthermore, the term "photographer" refers to any party having authorized access to the images and is not necessarily limited to the party that took the pictures (see column 3, lines 9-11). Therefore, the reception destination could be someone that has authorized access to the images other than the person who took the pictures. With respect to claim 9, the developer or store 12 typically has customer information inputting means to input customer information provided by the photographer. With respect to claims 2 and 3, column 5, lines 20-28 disclose information regarding the electronic image information transmitting service that is transmitted to the reception destination. This would include the ability to electronically e-mail an image to another party, order a visual print of a specific image in a variety of formats and sizes, such as photographic prints or enlargements, and photographic merchandise. With respect to claim 4, column 5, lines 40-48, disclose keeping the images on the image server for a fixed period of time, such as 30 days. It is noted that claim 4 recites three alternatives connected with the term "or". A reference that includes only one of the alternatives can read on the claim. With respect to claim 7, column 5, lines 16-35, and column 6, lines 56-67, disclose transmitting to the photographer thumbnail images, which are small volume electronic image information.

Art Unit: 2851

5. Claims 1 – 4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al. (U. S. Patent No. 6,324,521). Shiota et al. discloses in figure 8 and column 7, lines 3-37, that a customer 1 (second party) sends the film to the whole sale lab 14 (second party). The customer (second party) would inherently select whether or not to receive the electronic image information transmitting service (or why else would the wholesale lab go to all the effort of scanning and storing the images). The second party would input information about the first party. Scanner 7 converts an image on the developed film and the electronic image information is accumulated on image server 15. The first party transmits to the second party images through Internet 5. The reception destination could be the second party himself. It is also noted that the second party “selects” whether or not to receive the electronic image information transmitting service by either clicking or not clicking on the icon at the second party’s personal computer. With respect to claim 2, figure 2 discloses information regarding the electronic image information transmitting service. With respect to claim 4, column 8, lines 42-44 discloses that there is a time period for accumulating the electronic image information after which the information will be deleted. It is noted that claim 4 recites three alternatives connected with the term “or”. A reference that includes only one of the alternatives can read on the claim. With respect to claim 7, column 7, lines 45-67, and figure 5, disclose storing both a high resolution image and a low resolution image. The low resolution image or thumbnail image is transmitted to the customer.

Art Unit: 2851

6. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Sheridan (U. S. Patent No. 5,760,917). Sheridan discloses in figure 4 a scanner 6 to convert an image on a developed film into an electronic image. Computer 20 accumulates the electronic image. The hub communicates with a plurality of terminals 40A, 40B, and 40C. The second parties 40A, 40B, and 40C selects to receive the electronic image information transmitting service by selecting the icon on their respective terminals to download the images. Figures 1 and 2 disclose the ability to share albums with multiple users.

Conclusion

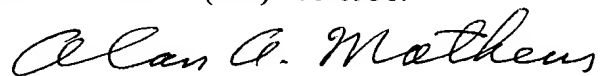
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Patent Application Publication US 2002/006750 is cited to show in figure 1 users 7 and 10 bringing film to a dealer branch shop or a dealer retail shop where the film is scanned and images are transmitted to a dealer head shop. The patents to Shaffer et al., Dellert et al., Allen et al., Miller et al., Maurinus et al., and Williams et al. are cited to show other networks for transferring electronic images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

Art Unit: 2851

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
February 3, 2003